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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,299	01/18/2002	Ted L. Bahns	10320US01	8720

7590

10/01/2004

Attention: Eric D. Levinson
Imation Corp.
Legal Affairs
P.O. Box 64898
St. Paul, MN 55164-0898

EXAMINER

MAYES, MELVIN C

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/050,299	Applicant(s) BAHNS ET AL.	
	Examiner Melvin Curtis Mayes	Art Unit 1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
4a) Of the above claim(s) 23 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20-22 is/are allowed.
- 6) ☒ Claim(s) 1 and 7-19 is/are rejected.
- 7) ☒ Claim(s) 2-6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/22/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

(1)

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-22, drawn to a method, classified in class 264, subclass 2.5.
- II. Claim 23, drawn to a set of optical data storage disks, classified in class 369, subclass 272.

(2)

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the process as claimed can be used to make a materially different product such as a check disk manufactured and provided separately to a customer for approval before manufacture of a replicated disk.

(3)

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

(4)

During a telephone conversation with Eric Levinson on a provisional election was made with traverse to prosecute the invention of Group I, claims 1-22. Affirmation of this election must be made by applicant in replying to this Office action. Claim 23 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

(5)

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 103

(6)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

(7)

Claims 1, 7-13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 64-086345 in view of the admitted prior art

JP 64-086345 discloses a method of inspecting the reproduction characteristics of a master disk for making optical disk comprising: providing a master disk 1; applying a UV curable resin 3 on the master; pressing a transparent disk 4 on the resin; curing the resin; irradiating the master with laser light under rotation to produce recording signals, inspecting the playback signals to see if the recording is satisfactory; if satisfactory, removing the transparent disk and adhered resin from the master; and using the master to product optical disk (Abstract and oral translation).

The admitted prior art teaches that for making optical disks, after the creating a master, the master is used to make a stamper which is used to make replica disks (pg. 1-2).

By applying a resin and transparent disk to the master for inspecting the characteristics of the master for making optical disk, a first generation check disk is obviously created from the master without destroying the master and tested. Creating a second master would have been obvious to one of ordinary skill in the art if the first master is inspected and found unsatisfactory for making an optical disk.

It would have been obvious to one of ordinary skill in the art to have used the satisfactory master to make a stamper, as the admitted prior art teaches that a replica disks are made from a stamper which is made from the master.

(8)

Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of Maenza 5,528,577.

Maenza teach that playback control tests for testing optical disc include block error rate, burst error, interpolations, radial noise and high frequency parameters in order to diagnose manufacturing problems (col. 7, lines 40-50).

It would have been obvious to one of ordinary skill in the art to have modified the method of the references as combined by inspecting the master by testing criteria such as burst error or noise, as taught by Maenza, as playback tests used for testing optical disc to diagnose manufacturing problems.

(9)

Claims 14-17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1 and 18 above, and further in view of Hong 5,688,447.

Hong teaches that creation of optical disks involves checking the master for accuracy, making a generation of stampers for the various disc generations and making optical discs by injection molding or rolling bead process (col. 1, line 37-11).

It would have been obvious to one of ordinary skill in the art to have modified the method of the references as combined by creating a second generation stamper from the stamper and making optical disk from the second generation stamper by injection molding or rolling bead process, as Hong teaches that stampers of various generations are made from a master for making optical disc by injection molding or rolling bead process. Making optical disc from a first generation, second generation or subsequent generation stamper would have been obvious to one of ordinary skill in the art as known for making optical disc from a master and stampers.

Allowable Subject Matter

(10)

Claims 2-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

(11)

Claims 20-22 are allowed.

Conclusion

(12)

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kasano et al. and Kubota et al. disclose inspecting the master by the conductive film formed thereon.

(13)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin Curtis Mayes whose telephone number is 571-272-1234. The examiner can normally be reached on Mon-Fri 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR


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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Melvin Curtis Mayes
Primary Examiner
Art Unit 1734

MCM

September 30, 2004